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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/073,598

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Nicole Beaulieu

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5942

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09/30/2008

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EXAMINER

MOSSER, ROBERT E

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

09/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/073,598	Applicant(s) BEAULIEU, NICOLE	
	Examiner ROBERT MOSSER	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7-12,14,15,18-22,33,35,36,39-41,43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 18th, 2008 and September 17th, 2008 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1, 3-4, 7-12,14-15,18-22, 33, 35-36, 39-41, and 43** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The applicant presents the following claim language in claims **1, 12, 33 and 41**:

“... wherein said controller is programmed to allow said person a choice of making an initial selection from among said user-selectable options at the start of said wagering game or to instruct said controller at the start of said wagering game to make said automated selection, ...”

This claim language argued as presenting a selection -between- a user selectable option and instructing the controller to make an automated selection additionally encompasses the presentation of an alternative statement wherein the

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controller is programmed to provide a user selection or an automated selection.

Presently the claim language is of a broader scope than argued by the applicant raising specific issue as to whether the construction of the argued claim language contains typographical errors. While this point may be considered subtle the following example amendment is provided purely for illustrative purposes of claim construction and not as an indication of allowable subject matter.

... wherein said controller is programmed to allow said person a choice of between making an initial selection from among said user-selectable options at the start of said wagering game or to instruct said controller at the start of said wagering game to make said automated selection, ...

The remaining claim not directly cited above are incorporated within this rejection due to their dependency on the claims addressed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **1, 3, 7-9, 12, 14, 18-20, 33, 35, 39-41, and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178 and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), and Bennett '178 teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference however the Board decision is silent regarding the newly amended features directed *to the automated selection being made according to the rules of the game being played and according to a strategy to optimize the likelihood that said person will receive a value payout.*

The above presented feature however is taught by the reference of Joshi (Figure 7, Col 8:56-9:18). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the optimized auto-selection feature of Joshi into the combination of Bennett '102 , Appellant's Admitted Prior Art , and Bennett '178 in order to enable the player to select a default selection of the Applicant's admitted prior art without sacrificing optimal game actions.

Claims **4, 15, 36, and 44** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Mayeroff, and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Mayeroff teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Claims **10-11, and 21-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett '102 in view of Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, Walker and Joshi (USP 6,485,367).

The combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), Bennett '178, and Walker teach the above listed claimed features as determined by the Patent Board Appeals in the decision rendered March 10th, 2008 incorporated herein by reference.

Response to Arguments

Applicant's arguments filed September 17th, 2008 have been fully considered but they are not persuasive. The Applicant proposes novelty/non-obviousness of the claimed invention premised on the inclusion of new limitations argued as absent in the prior art of Joshi.

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"Joshi does not disclose this feature of Applicant's claimed invention. Instead, in Joshi, the CPU of the gaming machine 10 is configured to make a recommendation at the start of each and every game. (Col. 4, lines 43-60; Col. 8, line 66 to Col. 9, line 17). The CPU is not programmed to allow a player to choose between making an initial selection from among a number of possible selections at the start of a game or instructing the controller at the start of the game to make an automated selection. That is, in Joshi's gaming machine, a player is not given an option as to whether the CPU makes a recommendation as to how a game is to be played. The CPU, in every instance, makes a recommendation as to a selection at the start of every game." (Page 11 of the Applicant's remarks dated August 18th, 2008)

The Applicant's remarks from the above demonstrate the applicant's recognition that the prior art of Joshi teaches the identification of selections due to an optimal strategy not the selection of these items, yet the applicant argues this indication as representing a selection.

"Thus, in this respect, Joshi clearly teaches away from Applicant's claimed invention wherein a player is allowed to choose between making an initial selection from a number of user-selectable options at the start of a game or instructing the controller at the start of the game to make an automated selection. "(Page 11 of the Applicant's remarks dated August 18th, 2008)

With regards to the applicant's suggestion Joshi clearly teaches the indications of optimal strategy and are not selections as argued.

"In this case, the CPU is recommending that the player hold the two pairs and discard the 5♠. Despite the CPU's recommendations, the player may choose to hold only the Q♣ and Q♦ and discard the 6♥, 6♦., and 5♠] in an attempt to go for three or four of a kind." (Joshi Col 4:49-53).

It is unclear as to what basis the Applicant relies upon when they have equated the recommendation of Joshi to the claimed selection. More precisely Joshi reference does not teach an automated selection feature (nor is it relied upon for such a teaching) but instead teaches that the automated selection of elements according to an strategy

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to optimize a game payout would have been obvious in view of the combination of Bennett '102, Appellant's Admitted Prior Art (Applicant's Specification 1:24 to 2:8), and Bennett '178.

Newly amended language into the independent claims is correlated to previously rejected dependent claim limitations such as those presented in now cancelled claim 2.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT E. PEZZUTO whose telephone number is (571)272-6996. The examiner can normally be reached on 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714

/R. M./
Examiner, Art Unit 3714